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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,387	04/11/2001	Louiss R. Jackson, JR.	COMP:0205	4526

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EXAMINER
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VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 09/832,387	Applicant(s) JACKSON,, LOUISS R.	
	Examiner Anatoly Vortman	Art Unit 2835	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-50.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_



Anatoly Vortman  
Primary Examiner  
Art Unit: 2835

Continuation of 5. Does NOT place the application in condition for allowance because:

Contrary to the Applicant's position, the finality of the rejection is believed to be proper, since there is NO REQUIREMENT in M.P.E.P. that a translation of the foreign reference must be provided concurrently with the First Office Action. Therefore, the Examiner believes that it would be unfair to award the Applicant with an extension of the prosecution merely because he / she had requested a translation of the reference. Also, please note that contrary to the Applicant's position, the reference (DE/29,616,175) had been FULLY applied in the First Office Action, since the Examiner had relied ONLY on drawings for showing CLEAR anticipation of the claimed device by the reference (see p. 2, paragraph 3 of the First Office Action). The Examiner believes that in the instant case the reference figures clearly and explicitly show all of the features of the device as claimed in claims 1-18, 20-32, 34-42, and 44-50 of the instant application. Furthermore, the Applicant did not specify any discrepancies between the aforementioned figures and the present invention, but had only argued that the device disclosed in DE/29,616,175 is not a personal computer. The Examiner believes that arguments regarding the personal computer definition are NOT persuasive. Also, the Applicant misconstrues the Examiner's reasoning by stating that Examiner had relied on a definition of the personal computer as a device that "enables individuals to perform a variety of computing or word-processing functions or both" (see p. 14, lines 8, 9 of the Reply). On the contrary, the Examiner had ONLY relied on the definition that the personal computer is "a single-user microcomputer designed for personally controllable applications" (see Final Office Action, p. 7, paragraph 7). As such, the Examiner believes that all Applicant's arguments directed to the assertion that the device of DE/29,616,175 is not a personal computer are IRRELEVANT, since they are based on a wrong definition.

The remaining Applicant's arguments are believed to be redundant, not persuasive, and have been fully addressed earlier in paragraph 7 of the Final Office Action as following:

Regarding the 35 USC 102 rejection, the main thrust of the Applicant's arguments is directed to the assertion that DE/29616175 does not teach a personal computer.

On the contrary, the Examiner believes that DE/29616175 does teach a personal (notebook) computer SPECIFICALLY ADAPTED for use as an electronic display device (see translation, p. 2, lines 20, 21; p. 3, lines 7-12; p. 7, lines 12+).

Furthermore, the Examiner has cited the following definition of "personal computer" from IEEE 100 The Authoritative Dictionary of IEEE Standards Terms (p. 812, column 2): "a single-user microcomputer designed for personally controllable applications." The Examiner believes that device of DE/29616175 is perfectly satisfies the aforementioned definition as well as the definition cited in the Applicant's remarks. Indeed, the electronic display device taught by DE/29616175 is built around standard personal notebook computer (see above) and may be employed by a single user (a person) for personally controllable application (i.e. for displaying pictures or text) in business or office environment, for example during presentations (see translation, "Description", lines 1+, following the title of the invention).

Also, contrary to the Applicant's assertion that DE/29616175 device is "merely "depicts static and /or dynamic images and / or text which are preferably constructed as files on a separate computer system" (see p. 11 of the Applicant's remarks), the Examiner would like to direct the Applicant's attention to Fig. 3 of DE/29616175 reference, which depicts the device comprising all necessary components of the computer in a portable package (i.e. adapted for use by a single user (person)): a processor (12), a graphic processor (13), a keyboard (17), a memory (14), a fixed-disk (hard drive) (15), a floppy drive (4), ports (16), a data interface (18), CD-ROM drive (19), a display (1, 6, 7), etc., all assembled in a personal-computer-type housing (2).

In view of the above, the Examiner would like to reiterate that device taught by DE/29616175 is a personal computer SPECIFICALLY ADAPTED for use as an electronic display device.

Regarding the 35 USC 103 rejection, the main thrust of the Applicant's arguments is directed to the assertion that references used in the rejection have been improperly combined and that there was no motivation to combine said references.

On the contrary, the Examiner would like to direct the Applicant's attention that motivations have been explicitly articulated in the bodies of the rejections (see p. 3 of the outstanding Office Action, paragraph # 5, lines 7, 8, 11, and 12; p. 4, lines 12-15, 18, and 19; p. 7, lines 2, 3, and 7).

Also, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

Also, the Examiner believes that one of ordinary skill in the computer art would have been motivated at the time the invention was made to combine teachings of the references used in 35 USC 103 rejections, because said person of ordinary skill in the art would have been reasonably expecting the success of the resulted combination. Indeed, as decided in In re O'Farrell, 7 USPQ 2d, 1673-1681, Fed. Cir. 1988, obviousness does not require absolute predictability of success. For many inventions that seem quite obvious, there is no absolute predictability of success until the invention is reduced to practice. There is always at least a possibility of unexpected results that would then provide an objective basis for showing that the invention, although apparently obvious, was in law nonobvious. In re Merck & Co., 800 F.2d at 1098, 231 USPQ at 380; Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1461, 221 USPQ 481, 488 (Fed. Cir. 1984); In re Papesch, 315 F.2d 381, 386-387, 137 USPQ 43, 47-48 (CCPA 1963). For obviousness under 35 U.S.C. 103, all that is required is a reasonable expectation of success. In re Longi, 759 F.2d 887, 897, 225 USPQ 645, 651-652 (Fed. Cir. 1985); In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Responding to the Applicant's position, that the Examiner utilized the "hindsight reconstruction" while rejecting the claims under 35 USC 103 (p. 14, lines 11+ of the Applicant's remarks), please note that it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Also, contrary to the Applicant's position that "the Examiner's statement may be taken as Official Notice..." (p. 18, lines 10, 11 of the Applicant's remarks), please note that the Examiner had NOT taken the Official Notice in the instant case.

In response to the Applicant's remarks directed to the patentable weight of the functional language (see p. 19 of the Applicant's remarks),

The functional limitations of the claim is given their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application only if said functional limitations invoke 35 U.S.C. 112, sixth paragraph. (See Donaldson, 16 F.3d at 1194, 29 USPQ2d at 1850 (stating that 35 U.S.C. 112, sixth paragraph "merely sets a limit on how broadly the PTO may construe means-plus-function language under the rubric of reasonable interpretation" ).

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for " or "step for ";
- (B) the "means for " or "step for " must be modified by functional language;
- and,
- (C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function.

With respect to the first prong of this analysis, a claim element that does not include the phrase "means for" or "step for" will not be considered to invoke 35 U.S.C. 112, sixth paragraph.(MPEP 2181).

In the instant case, since claims functional limitations (i.e. "wall mountable" ) do not include the phrase "means for" or "step for" said functional limitations have not been considered to invoke 35 U.S.C. 112, sixth paragraph, i.e. they have not been interpreted by the Examiner in light of and consistent with the written description of the invention in the application.

Furthermore, since claim's functional limitations in the instant case did not invoke 35 U.S.C. 112, sixth paragraph, the only venue for the Examiner to give the aforementioned functional limitations patentable weight would have been to find in the claims a sufficient structure in support of said functional limitations (as decided in In re Fuller) which claims failed to provide.

Therefore, since claims functional limitations (i.e. "wall mountable" ) did not invoke 35 U.S.C. 112, sixth paragraph and did not satisfy In re Fuller, those functional limitations have not been given patentable weight.

In conclusion, regarding the rejections of the claims 19, 33, and 43, the Applicant's arguments that "The Lochridge reference explicitly teaches away from integrating a display with the computer body" (p. 24 of the Applicant's remarks, lines 5, 6) are believed to be irrelevant to the rejections of said claims 19, 33, and 43. The only teachings which have been taken by the Examiner from Lochridge reference are those directed to the use of a plurality of the keyhole slots for hanging the computer (see outstanding Office Action, p. 7, lines 1+) not the teachings of "integrating a display with the computer body" (see Applicant's remarks, p. 24, lines 5, 6) as it has been suggested by the Applicant.

*A. Vale*

ANATOLY VORTMAN  
PRIMARY EXAMINER